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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,194	09/14/2000	Hisashi Saiga	55051(1117)	5757

21874 7590 03/28/2003

EDWARDS & ANGELL, LLP
P.O. BOX 9169
BOSTON, MA 02209

EXAMINER
BASOM, BLAINE T

ART UNIT	PAPER NUMBER
2173	

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/646,194	SAIGA ET AL.	
	Examiner	Art Unit	
	Blaine Basom	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) *1-27* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *28-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 September 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-15, drawn to a data-displaying device, and classified in class/subclass 345/858, wherein a visual confirmation guide is displayed to distinguish a specific area of data.
Group II, claims 16-27, drawn to an electronic book displaying device, and classified in class/subclass 345/901, wherein a mental image outputting means and reading effect control means are included to output supplemental information regarding displayed book data.
Group III, claims 28-37, drawn to a data storage medium, and classified in class/subclass 345/784, wherein the data storage medium has display data recorded thereon for providing a scroll display on a display screen.

The invention listed as Groups I-III do not relate to a single inventive concept under PCT rule 13.1 because, under PCT rule 13.2, they lack the same or corresponding technical features for the following reasons: Group I relates to distinguishing a specified area of data on a display,

Group II relates to adding supplemental information to data in an electronic book, and Group III relates to providing a scroll display.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Applicants' Attorney on March 3, 2003 a provisional election was made with traverse to prosecute the invention drawn claims 28-37, a data storage medium with display data recorded thereon for providing a scroll display on a display screen. Affirmation of this election must be made by the Applicant in replying to this Office action. Claims 1-27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i)

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically regarding claim 28, the phrase " the display data is recorded by every specified unit" does not make sense within the context of the claim. Moreover, the phrase "provided each" which recited in claim 28 is not distinct; it is unclear whether the "display data" or the "every specified unit" is provided with information for scroll display. Claims 29-37 depend on rejected claim 28, and include all of the limitations of claim 28, thereby rendering these dependent claims indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 28-31, and 33-37 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,634,064, which is attributed to Warnock et al. (and hereafter referred to as

"Warnock"). In general, Warnock discloses a method for presenting a document on a computer display. As this document is stored in the memory of the computer (see column 2, lines 38-41), such a memory is considered a data storage medium with display data recorded thereon, like that expressed in claims 28-37. Specifically regarding claims 28 and 29, Warnock discloses that the document is stored as a Portable Document Format (PDF) document (see column 5, lines 9-30), and that such a PDF document consists of "formatted pages" (see column 1, line 66 – column 2, line 6). It is therefore understood that a document, stored as a PDF document on a storage medium, is recorded by specified units, and more specifically, it is understood that these specified units of recorded display data are pages. Warnock discloses that a document may include one or more articles, wherein each article may be broken into various sections and scattered throughout the document (see column 2, lines 9-15). Moreover, an article can span more than one page (see column 6, lines 4-8). Warnock discloses that a user can read a particular article by selecting an "article view" mode, whereby the selected article is displayed in an enhanced view mode. In other words, a portion of the selected article is displayed to the user, and is automatically panned and zoomed to fit the display in order to enhance its readability (see column 3, lines 17-22). Moreover, the various sections of the article are linked together, and the article may be scrolled, so that the entire article may be read continuously (see column 2, line 52 – column 3, line 2). Warnock specifically discloses that,

...the linkages between the article sections are preferably circular. That is, the first article section is preferably linked to the last article section such that forward scrolling from the last article section will access the first article section, and such that a rearward scrolling from the first article section will access the last article section. (See column 7, lines 42-50).

It is therefore understood that each of the article sections, which compose the pages of the document, include information for scroll display as recited in claim 28, and more specifically, it

is understood that this information for scroll display includes information for scrolling display data in different directions, as is recited in claim 30. And because an article, which spans multiple pages, consists of multiple article sections that are linked together in order to provide continuous scrolling of the article, it is understood that this information for scroll display also includes information for linking with information for another scroll display.

With respect to claims 33 and 34, in the "article view" mode described by Warnock, a portion of a selected article is displayed to the user, and is automatically zoomed to fit the display window in order to enhance its readability, as is described above. Therefore, it is understood that the information for scroll display, as discussed above, includes information for specifying a scroll display area. Moreover, Warnock discloses a "maximum zoom," which is indicated by the reader of an article. When automatically zooming the portion of the selected article, the portion is first enlarged by the maximum zoom. If it is then found that the selected portion is too large for the window, the portion is reduced by an appropriate amount (see column 11, lines 4-30). Consequently, it is understood that the information for scroll display also includes information for specifying a scale of enlargement or reduction of a display area for scroll display.

Regarding claim 35, Warnock discloses the above-described document may be comprised of text and graphics and may also include multimedia content such as sound or video (see column 6, lines 10-17). It is interpreted that such content is reproduced in synchronism with the scrolling of an article. For example, when scrolling a text document, the text is produced in synchronism with the scrolling, as is known in the art. Consequently, it is understood that the

above-described information for scroll display includes synchronous reproduction information for specifying a display data content to be reproduced in synchronism with the scroll display.

In reference to claim 36, Warnock discloses that a monitor is used for reproducing and displaying a document (see column 4, lines 40-44). As described above, such a document is stored in a storage medium and is scrolled based on the above-described information for scroll display. This monitor described by Warnock is therefore considered equivalent to the "display device" recited in claim 36.

As per claim 37, Warnock teaches that a "hand" icon may be selected by a user, which results in the display of a "hand cursor." This hand cursor includes an arrow that indicates a scrolling direction (see column 10, lines 25-35). For example, by clicking on an article with the hand cursor, the article is scrolled in the direction indicated by the arrow (see column 11, lines 31-36). This hand cursor is therefore considered a scroll indicating means for a scroll display. Consequently, the monitor, i.e. displaying device, disclosed by Warnock is provided with a scroll indicating means, as expressed in claim 37.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over the U.S. Patent of Warnock, which is described above, and also over, Japanese Patent No. 5-323941, which is

attributed to Michihiro Ota (and hereafter referred to as "Ota"). As described above, Warnock discloses a data storage medium with display data recorded thereon, as is recited in claim 28, wherein the display data is provided with information for scroll display on a display screen. Warnock however does not explicitly disclose that this information for scroll display includes information on a scroll display speed, as is expressed in claim 32.

Like Warnock, Ota discloses a method for presenting a document on a display screen whereby the document can be scrolled. Regarding the claimed invention, Ota teaches that the scroll speed may be varied according to the number of characters displayed (see the abstract of Ota). Consequently it is understood that the document described by Ota is associated with information for scroll display, wherein this information for scroll display includes information on a scroll display speed.

It would have therefore been obvious to one of ordinary skill in the art, having the teachings of Warnock and Ota before him at the time the invention was made, to modify the information for scroll display taught by Warnock, such that it includes information on a scroll display speed, as taught by Ota. It would have been advantageous to one of ordinary skill to utilize such a combination because the resulting document scrolling speed would match the document reading speed of a user, as is taught by Ota (see the abstract of Ota). This is a desirable attribute for a document displaying system.

Conclusion

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. The applicant is required under 37 C.F.R. §1.111(C) to

consider these references fully when responding to this action. The Shibata et al. U.S. Patent cited therein presents a system for displaying published articles. The articles may be zoomed, and scrolled. The Stoub U.S. Patent cited therein teaches that documents may be displayed as linked pages, wherein these pages may be scrolled in a plurality of directions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blaine Basom whose telephone number is (703) 305-7694. The examiner can normally be reached on Monday through Friday, from 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7238 for regular communications and (703) 746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

btb
March 21, 2003

JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100